

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 20, 2006 ("Office Action"). Claims 1-5, 9, 10, 14-18, 22, 23 and 27-31 are pending in the application. The Examiner rejects Claims 1-5, 9, 10, 14-18, 22, 23 and 27-31. Applicant respectfully requests reconsideration and allowance of all pending claims.

Interview

Applicant thanks the Examiner for the telephonic interview that occurred on January 22, 2007. During the interview, the Examiner and the undersigned attorney for Applicant discussed "collecting, into a first list, results associated with one or more negative terms, and collecting, into a second list, results associated with one or more positive terms while omitting from the second list any results that are in the first list" as recited in Claim 1. During the interview, the Examiner acknowledged that the discussion of the cited references in the Final Office Action fails to address the foregoing aspects of Claim 1. To correct this error, the Examiner stated that he will withdraw the Final Office Action and prepare a new Office Action.

Section 112 Rejections

The Examiner rejects Claim 1 under 35 U.S.C. § 112, second paragraph. The Examiner asserts that Claim 1 fails to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicant respectfully traverses this rejection for at least the following reasons. First, by reciting specific method steps, Claim 1 satisfies the definiteness requirements of 35 U.S.C. § 112, second paragraph. Second, the Examiner cannot maintain a rejection based on indefiniteness simply because the Examiner prefers a different mode of expression. Third, the rejection is improper because the Examiner confuses breadth with indefiniteness.

First, by reciting specific method steps, Claim 1 satisfies the definiteness requirements of 35 U.S.C. § 112, second paragraph. Claim 1 recites:

A method of processing a database service query, comprising:
receiving a service query,
obtaining a sum of terms associated with the service query by
expanding at least one nested term into one or more un-nested terms,
evaluating the sum of terms as a plurality of SQL instructions, wherein
the sum of terms comprises one or more positive terms and one or more
negative terms,
determining a plurality of results associated with the sum of terms,
wherein the determination comprises:
collecting, into a first list, results associated with the one or
more negative terms, and
collecting, into a second list, results associated with the one or
more positive terms while omitting from the second list any results that
are in the first list.

In rejecting Claim 1, the Office Action quotes the following portion of the specification:

It should be noted that a database that supports SQL may not supply a subtraction operator. In such instances a problem in processing the sum of terms as described above may arise. In order to process (or evaluate) a subtraction, the method according to the present application: collects all positive terms in a list; collects all negative terms into another list; and then subtracts the positive term list and the negative term list whilst ignoring duplicates.

An alternative to the subtraction process noted above is to collect all negative terms in a list, and in the process of collecting all positive terms in another list, only keep the terms that are not in the negative list. As a result, this positive list will have the subtracted results.

(Specification; page 9, line 27 – page 10, line 6).¹ After quoting the foregoing portion of the specification, the Office Action states:

Applicant has not disclosed what database does not supply subtraction. Whereas the applicant is claiming for all databases instead of a specific database. To expedite the prosecution, Applicant has been give [sic] a change [sic] to amend the claim to incorporate the specific database by combining the claim 4 with claim 1 and repeating the process for other claims.

(Office Action; page 3).

The Examiner's assertion – that “applicant is claiming for all databases instead of a specific database” – is misleading. Rather than “claiming for all databases” as suggested by the Examiner, Claim 1 is directed to a method that comprise the specific steps recited in

¹ In citing the foregoing portion of the specification, Applicant does not intend to limit any claims to any particular embodiment. Applicant merely quotes the particular portion of the specification quoted in the Office Action.

Claim 1. There is no dispute that the specific steps of Claim 1 are definite. Accordingly, Claim 1 satisfies the requirements of 35 U.S.C. § 112, second paragraph.

Second, the Examiner cannot maintain a rejection based on indefiniteness simply because the Examiner prefers a different mode of expression. It is well established that, “if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph.” MPEP § 2173.02. In this case, the Examiner suggested that Applicant amend Claim 1 to recite “receiving an X.500 or LDAP service query” rather than “receiving a service query.” (Office Action; page 3). This suggestion shows that the Examiner merely prefers a different expression of the “service query” recited in Claim 1. Because the Examiner merely “prefers a different mode of expression...the claim must not be rejected under 35 U.S.C. 112, second paragraph.” MPEP § 2173.02.

Third, the rejection is improper because the Examiner confuses breadth with indefiniteness. It is well established that:

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

MPEP § 2173.04. As explained above, the Examiner suggests that Applicant amend Claim 1 to recite “receiving an X.500 or LDAP service query” rather than “receiving a service query.” (Office Action; page 3). This suggestion is clearly based on breadth -- not indefiniteness. The mere breadth of a claim term does not establish indefiniteness. MPEP § 2173.04. Accordingly, the Office Action fails to properly establish a rejection under 35 U.S.C. § 112, second paragraph. The rejection of Claim 1 must therefore be withdrawn. For at least the foregoing reasons, Applicant respectfully requests reconsideration and allowance of Claim 1.

In rejecting Claims 9, 14, 22, and 31, the Examiner employs the same rationale used with respect to Claim 1. Accordingly, for at least the reasons stated above with respect to Claim 1, Applicant respectfully requests reconsideration and allowance of Claims 9, 14, 22, and 31.

Section 103 Rejections

The Examiner rejects Claims 1-5, 9-10, 14-18, 22-23 and 27-31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,356,892 B1 issued to Corn, et al. ("*Corn*"), in view of U.S. Patent No. 6,112,198 issued to Lohman, et al. ("*Lohman*"), and in view of U.S. Patent No. 5,412,804 issued to Krishna, ("*Krishna*"). Applicant respectfully traverses this rejection and requests reconsideration and allowance of Claims 1-5, 9-10, 14-18, 22-23 and 27-31.

The cited references fail to teach, suggest, or disclose each aspect of Claim 1. In particular, the cited references fail to teach, suggest, or disclose "collecting, into a first list, results associated with the one or more negative terms...and collecting, into a second list, results associated with the one or more positive terms while omitting from the second list any results that are in the first list" as recited in Claim 1. These elements of Claim 1 are not discussed, in the Office Action, with respect to the cited references. As explained above, the Examiner indicated that he will prepare a new Office Action.

Applicant respectfully submits that the *Corn-Lohman-Krishna* combination fails to disclose the foregoing aspects of Claim 1. The cited references describe various methods for processing database queries. In particular, *Corn* describes a method for translating an LDAP filter-based query to an SQL subquery. (*Corn*; abstract; col. 3, ll. 1-41). *Lohman* describes a method for parallel processing of subtasks associated with a query. (*Lohman*; abstract; col. 1, ll. 42-59). Finally, *Krishna* describes a method for un-nesting nested query blocks. (*Krishna*; abstract; col. 3, ll. 19-41). None of these references teach, suggest, or disclose "collecting, into a first list, results associated with the one or more negative terms" as recited in Claim 1. In addition, none of the cited references teach, suggest, or disclose "collecting, into a second list, results associated with the one or more positive terms" as recited in Claim 1. The cited references also fail to teach, suggest, or disclose "omitting from the second list any results that are in the first list" as recited in Claim 1. Because the cited references fail to teach, suggest, or disclose these aspects of Claim 1, the cited references do not support the rejection.

In rejecting Claims 9, 14, 22, and 31, the Examiner employs the same rationale used with respect to Claim 1. Accordingly, for at least the reasons stated above with respect to Claim 1, Applicant respectfully requests reconsideration and allowance of Claims 9, 14, 22, and 31.

Claim 4 depends from independent Claim 1, shown above to be allowable. The rejection of Claim 4 is inconsistent with the discussion of Claim 1 in the Office Action. As explained above, the Examiner suggests that Claim 1 would be allowable if amended to include the elements recited in Claim 4. (Office Action; page 3). Despite this suggestion, the Examiner rejects Claim 4 in the Office Action. As a dependent claim, Claim 4 comprises all of the elements of Claim 1. Thus, the Examiner's rejection of Claim 4 is inconsistent with his suggestion to amend Claim 1 to include the elements of Claim 4. For at least the foregoing reasons, Applicant respectfully requests reconsideration and allowance of Claim 4.

Claims 2-3, 5, 10, 15-18, 23, and 27-30 depend from independent claims shown above to be allowable. In addition, these claims recite further elements not taught, suggested, or disclosed by the cited references. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 2-3, 5, 10, 15-18, 23, and 27-30.

CONCLUSION

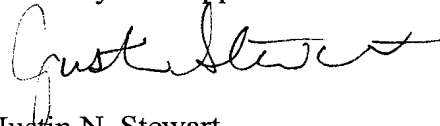
Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney at (214) 953-6755 at the Examiner's convenience.

Although no fees are believed due for this response, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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